

## REMARKS

The following remarks are provided in response to the Office Action dated February 11, 2004 in which the Examiner:

- rejected claims 1-21 under 35 U.S.C. §102(e) as being anticipated by United States Patent No. 6,253,322 to Susaki et al., (hereinafter Susaki); and
- provisionally rejected claims 1-21 under the judicially created doctrine of double patenting over claims 1, 4-8, 11-13, 16-19, 22, 23, 26, 27, and 30 of co-pending Application No. 09/945,913.

The applicant respectfully requests reconsideration of the above referenced patent application in view of the amendments and remarks set forth herein, and respectfully requests that the Examiner withdraw all rejections.

### **35 U.S.C. §102(e)**

The Examiner rejected claims 1-21 under §102(e) as being anticipated by Susaki. For at least the foregoing reasons the applicant traverses the Examiner's rejection.

To establish a *prima facie* case of anticipation under 35 U.S.C. §102, the Examiner must supply a single prior art document that alone teaches “. . . **every** aspect of the claimed invention either explicitly or impliedly.” (emphasis added) (See M.P.E.P. §706.02) If the Examiner cannot show that the single prior art document asserts each and every element and limitation of the applicants' claims, then the Examiner has failed to establish a *prima facie* case of anticipation for that claim. To overcome the Examiner's anticipation rejection, the applicant must only demonstrate that the cited prior art document fails to teach one element or limitation present in the claim.

Currently amended independent claim 1 recites in a salient portion:

. . . signing, by the second digital certificate issuing authority, the once signed electronic document to obtain a twice signed electronic document,

**wherein the second digital issuing authority is hierarchically superior to the first digital certificate issuing authority.**

(emphasis added)

Currently amended independent claims 6, 11, 16, 18 and 20 recite a similar limitation as highlighted above.

The Examiner relies on Figures 1 (blocks 151, 152, and 180), 9c (blocks 1001a, 1001b, and 1001c) and column 2, line 57 bridging column 3, line 10 and column 13, lines 11-52 to teach transmitting the once signed electronic document to a second digital certificate issuing authority to obtain a twice signed electronic document. The cited portions of Susaki, however, **do not teach that the second digital certificate issuing authority is hierarchically superior to the first digital certificate issuing authority.**

The applicant respectfully submits that currently amended independent claims 1, 6, 11, 16, 18, and 20 recite at least this limitation not taught by Susaki. Accordingly, the applicant respectfully requests that the Examiner allow independent claims 1, 6, 11, 16, 18, and 20. Further, the applicant requests that the Examiner allow dependent claims 2-5, 7-10, 12-15, 17, 19, and 21-27 as each depends on a patentable independent claim.

### **Provisional Double Patenting Rejection**

The Examiner provisionally rejected claims 1-21 under the judicially created doctrine of double patenting over claims 1, 4-8, 11-13, 16-19, 22, 23, 26, 27, and 30 of co-pending Application No. 09/945,913. Filed herewith is a terminal disclaimer Form PTO/SB/25 in compliance with 37 C.F.R §§ 1.130(b) and 1.321(c).

CONCLUSION

For at least the foregoing reasons, the applicant submits that he has overcome the Examiner's rejections and that he has the right to claim the invention as set forth in the listed claims.

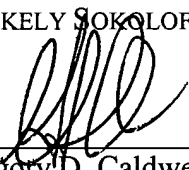
Please charge any shortages and credit any overcharges to our Deposit Account number 02-2666.

Respectfully submitted,

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Dated

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